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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:

Ward D. Parkinson

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Art Unit: 2827

Serial No.: 10/634,153

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Examiner: Viet Q. Nguyen

Filed: August 4, 2003

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Atty Docket: ITO.0553US
P16341

For: Analog Phase
Change Memory

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Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

In response to the new arguments raised in the Examiner's Answer, the following reply brief is provided.

While apparently conceding (see Answer at page 14) that all the cited references really are digital in nature, the Examiner contends, in effect, that each of these references could have done what is claimed. But "could have" is never good enough. What we have here is the situation that the thinking was always to go digital. The fact that someone could have done analog if they had wanted to and if they had thought of it is, of course, always the case. There is no requirement that the technical hurdle to accomplish something be insurmountable. What we have here is the situation where the Examiner contends that the technical hurdle was surmountable, but none of the many cited references taught storing analog, as opposed to digital, information.

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Cynthia L. Hayden

Most telling is the following quote:

Even though the patents might convert these analog current-voltage values into digital storage state as their end results, the Appellant's arguments are still not persuasive and convincing because the patent's structure is already capable of storing analog signal values by just using these resistors in phase change material without implying the end results, unless its structure would have been obvious to one having ordinary skill in the art as a so-called type of 'analog' structure.

See Answer at page 14.

But the standard for patentability is not "could have." There must be some teaching of a reason and a rationale to do so even if, as the Examiner argues, it would have been easy to do so. Here, we have the admission that all the cited references relate to digital storage, not analog storage. Therefore, there can be no rationale to modify them to do what is claimed.

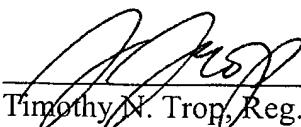
Therefore, the rejection should be reversed.

The Examiner also raises an issue with respect to dependent claim 2, suggesting that the references teach away the Applicant's claim 2 "because these claims also specifically recite that information/data can be stored in either digital or analog form (see claim 2)." See Answer at page 5. But that is not what claim 2 calls for. Claim 2 calls for "selectively enabling" either digital or analog data. Thus, you need the capability to selectively do analog or digital data. The structure is shown in the present application to do that. None of the cited references teach such a structure. They all teach digital structures and, according to the Examiner, one of ordinary skill in the art could have thought to do analog. But even if the Examiner was correct (and he is not) there is no ability to selectively enable either digital or analog storage.

Therefore, the rejections of claims 2, 12, 22, 24, and 25 should be reversed.

Respectfully submitted,

Date: October 2, 2006



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